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EXAMINER

PATEL, ANAND B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/081,005

Filing Date: February 19, 2002

Appellant(s): OAR ET AL.

Douglas L. Weller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/15/05 appealing from the Office action mailed 7/21/05.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent No 6785724 to Drainville et al and US Patent No 6317831 to King.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 6785724 to Drainville et al (Drainville), in view of US Patent No 6317831 to King.

- As per claim 23, Drainville discloses a method by which a portable computer in a sleep mode

(22) responds to a communication from the client, the method comprising the following:

- Waking the portable computer from the sleep mode in response to the communication (column 1, lines 62-64);
- Recognizing the communication by the portable computer (inherent given the computer responding to the communication);
- Responding to the communication by the portable computer, including the following:
 - Generating a response (column 2, lines 25-31), and
 - Transmitting the response to the client, the transmitting being performed via another communication transmission (column 2, lines 25-31); and,

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- Returning the portable computer to the sleep mode (column 6, lines 37-40; the phone tap method described in column 6, lines 3-13 is a method of waking the server, thus the system is inherently put to sleep after the client request has been answered).

Drainville fails to disclose a personal digital assistant. King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54). An advantage of the system taught by King is a quickly achieved secure connection (column 4, lines 61-66). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Drainville by King. Motivation to combine is the ability to quickly create a secure connection.

- As per claim 24, King teaches a method wherein the transmission of the response by the portable computer is made directly to the personal digital assistant via a wireless network (figure 9).
- As per claim 25, Drainville teaches a method wherein the communication is an access by the client into a database within the portable computer (column 1, lines 62-64; column 2, lines 25-31). King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54).
- As per claim 26, Drainville discloses a method by which a portable computer in a sleep mode (22) responds to a communication from the client, the method comprising the following:
 - Waking the portable computer from the sleep mode in response to the communication (column 1, lines 62-64);
 - Recognizing the communication by the portable computer (inherent given the computer responding to the communication);
 - Performing an action in response to the communication by the client (column 2, lines 25-31);
 - Returning the portable computer to the sleep mode (column 6, lines 37-40; the phone tap method described in column 6, lines 3-13 is a method of waking the server, thus the system is inherently put to sleep after the client request has been answered).

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King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54).

- As per claim 27, King teaches a method wherein the wireless communication is performed via a wireless network (904).
- As per claim 28, Drainville teaches a method wherein the communication is an access by the client into a database within the portable computer (column 1, lines 62-64; column 2, lines 25-31).

King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54).

- As per claim 29, Drainville discloses storage media, the storage media storing software which when executing on a portable computer (22) performs a method by which the portable computer responds to a communication from a client, the method comprising the following:
 - Waking the portable computer from the sleep mode in response to the communication (column 1, lines 62-64);
 - Recognizing the communication by the portable computer (inherent given the computer responding to the communication);
 - Performing an action in response to the communication by the client (column 2, lines 25-31);
 - Returning the portable computer to the sleep mode (column 6, lines 37-40; the phone tap method described in column 6, lines 3-13 is a method of waking the server, thus the system is inherently put to sleep after the client request has been answered).
- King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54).
- As per claim 30, King teaches a storage media wherein the wireless communication is performed via a wireless network (904).

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- As per claim 31, Drainville teaches a storage media wherein the communication is an access by the client into a database within the portable computer (column 1, lines 62-64; column 2, lines 25-31). King teaches communication that is a wireless communication from a personal digital assistant (column 15, lines 52-54).

(10) Response to Argument

1. Examiner notes Appellant's summary of the case law in Section A; however, this section fails to set forth any specific deficiencies in the rejections and is therefore moot.
2. Examiner notes Appellant's summary of the claimed invention and prior art. The examiner disagrees with Appellant's characterization of the teachings of the prior art as will be discussed below in response to Appellant's allegation of specific errors.
3. Appellant states, "In essence, the claimed invention provides a way by which a PDA can easily access information within a portable computer in a sleep mode". Examiner disagrees. Appellant is stating that the computer is in a sleep mode while the portable digital assistant (PDA) is accessing information residing on the portable computer; however, this is not claimed. The claims state that the portable computer is in a sleep mode and is then awakened in response to a wireless request from the PDA to access information. The PDA and portable computer then communicate wirelessly and a response to the request is transmitted. Drainville teaches a client that sends a communication to a portable computer that is in a sleep mode (column 1, lines 62-64). In response to the communication, the portable computer is awakened and then responds to the communication (column 1, lines 62-64; column 2, lines 25-31). King teaches that a PDA can be used to wirelessly communicate with a computer (column 15, lines 52-54). Therefore, by modifying the system of Drainville with the PDA with wireless communication taught by King, it would be obvious to one of ordinary skill in the art at the time of invention that a PDA could wirelessly wake a portable computer with a communication and receive a response to the communication.
4. Appellant states, "neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer in a sleep mode". Examiner agrees. Appellant is stating that neither reference deals with communication between a PDA and a personal computer; however, this is not claimed. The claims state that the computer receiving the communication is a portable computer (able to

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be moved), not a personal computer (built for use by an individual). Examiner notes that Drainville teaches a portable computer (22) as claimed in the instant invention.

5. Appellant argues in Section C1 that neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer in a sleep mode. Examiner agrees. If Drainville disclosed this feature, the rejection would have been made under 35 U.S.C. § 102 rather than 35 U.S.C. § 103. Similarly, if King disclosed this feature it would have been a rejection under 35 U.S.C. § 102. It is the combination of the teachings of Drainville and King that make a portable computer being awakened from a sleep mode by a PDA obvious to one of ordinary skill in the art.

6. Appellant argues in Section C1 that Drainville does not disclose a portable computer. Examiner disagrees. The server 22 is capable of being moved and is thus portable. In addition, it would have been obvious to one of ordinary skill in the art at the time of invention that a server would need to be portable, as evidenced by numerous patents. For instance, US Patent No 5699357 to Carvey teaches a server that is portable and battery powered, and US Patent No 6470401 to Peterson teaches a server being a portable laptop computer. Also, the fact that the computer has been moved from the factory where it was made to the point of operation evidences that the server is portable. Appellant further argues that since the server is wired to a phone line through a modem it is not portable. Extending this argument, laptops, which are connected to the Internet via phone lines, are not portable. This line of reasoning is fallacious since laptops are, by definition, portable.

7. Appellant states "King does not disclose or suggest communication between a personal digital assistant and a personal computer in a sleep mode". Examiner agrees. Appellant is stating that King does not disclose communication between a PDA and a personal computer; however, this is not claimed. The claims state that a portable computer receives a communication. There is a distinction between the personal computer that the Appellant references, which is for use by one or a small group of individuals, and the portable computer that the instant invention claims, which is capable of being moved.

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8. Appellant argues in Section C1 that King does not disclose or suggest communication between a PDA and a personal computer in a sleep mode and does not disclose any entity in sleep mode of being awakened from a sleep mode. Examiner agrees. Again, if King disclosed these features the rejection would have been under 35 U.S.C. § 102, instead of 35 U.S.C. § 103. The modification of Drainville with King makes a portable computer being awakened and communicating with a PDA obvious to one of ordinary skill in the art at the time of invention.

9. Appellant argues in Section C1 that Drainville does not disclose a portable computer, does not disclose a PDA, and does not disclose a portable computer being awakened from a sleep mode by a PDA. Examiner agrees. King is used to teach that a PDA can be used to wirelessly communicate with the portable computer disclosed in Drainville. The system taught by Drainville, being modified to include the PDA taught by King, would make the instant invention obvious to one of ordinary skill in the art at the time of invention.

10. Appellant argues in Section C1 that the on demand server, in Drainville, is not a portable computer. Examiner disagrees. As discussed above with respect to paragraph 6, the server disclosed in Drainville is a portable computer.

11. Appellant argues in Section C1 that the tapping web server, also in Drainville, is not a PDA. Examiner agrees. Should this feature have been disclosed in Drainville, a 35 U.S.C. § 102 rejection would have been made. Instead, a PDA communicating wirelessly was disclosed in King and the combination of the Drainville and King references would have made the instant invention obvious to one of ordinary skill in the art at the time of invention. Further, Examiner does not rely on tapping web server in the rejection of the instant invention and cites the client 10 of Drainville as sending the communication that wakes and communicates with the portable computer.

12. Appellant argues in Section C1 that neither King nor Drainville disclose or suggest the portable computer responding to the PDA via another wireless communication. Examiner disagrees. The test for

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obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). King teaches wireless communication with a PDA and all necessary modifications for its use including wireless responses.

13. Appellant argues in Section C1 that King does not disclose any communication that wakes up a portable computer and does not disclose or suggest any transmissions being made in response to a portable computer being awakened from a sleep mode. Examiner agrees. Drainville teaches waking a portable computer (column 1, lines 62-64). Drainville also teaches responding to communications by the portable computer (column 2, lines 25-31). It is the combination of Drainville and King which teach a PDA sending wireless communications which awaken a portable computer and cause a response to be sent to the PDA from the portable computer.

14. Appellant states, "In Drainville, client 10 does not communicate with the on-demand server 22 until after web server 22 has been awakened by the tapping server. Therefore, no communications (wireless or otherwise) from client 10 is used to wake up the on-demand server." Examiner disagrees. Appellant is stating that since the client does not directly wake the server it has no part in waking the server. This limitation, however, is not claimed. The claims state that a portable computer is awakened from a sleep mode in response to a wireless communication from a PDA. Drainville discloses a portable computer (22) that is awakened from a sleep mode in response to a wireless communication (column 1, lines 62-64) from a client (10). King teaches a PDA that communicates wirelessly with a computer (column 15, lines 52-54). The substitution of the PDA taught by King for the client taught by Drainville would therefore meet the limitations claimed in the instant invention.

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15. Appellant argues in Section C2 that in Drainville, with or without modification based on King, the on-demand server is awakened by a tap from tapping web server 30. Examiner agrees; nevertheless this is not germane to the claimed subject matter. The claims state that the portable computer is awakened in response to a communication from a PDA but the communication need not directly wake the portable computer. Drainville teaches a client (10) waking a portable computer in a sleep mode (22) in response to a communication (column 1, lines 62-64). King teaches a PDA that performs wireless communication (column 15, lines 52-54). With the PDA taught by King substituted for the client of Drainville, one of ordinary skill in the art at the time of invention would produce a PDA that sends a wireless communication to a portable computer and in response to this communication, the portable computer is awakened.

16. Appellant states, "In essence, the claimed invention provides a way by which a PDA can easily access information within a portable computer in a sleep mode". Examiner disagrees. Appellant is stating something that is not claimed. The computer is not in a sleep mode while the portable digital assistant (PDA) is accessing information residing on the portable computer; however, the portable computer is in a sleep mode prior to any communication and is awakened in response to a communication from the PDA. Drainville teaches a client that sends a communication to a portable computer that is in a sleep mode (column 1, lines 62-64). Drainville also teaches that in response to the communication, the portable computer is awakened and then responds to the communication (column 1, lines 62-64; column 2, lines 25-31). King teaches that a PDA can be used to wirelessly communicate with a computer (column 15, lines 52-54). The combination of the system disclosed by Drainville and the PDA taught by King would have made it obvious to one of ordinary skill in the art at the time of invention that a PDA could wirelessly wake a portable computer with a communication and receive a response to the communication.

17. Appellant states, "neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer in a sleep mode". Examiner agrees. Appellant is stating that

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which is not claimed. Neither reference deals with communication between a PDA and a personal computer because the claims state that the computer receiving the communication is a portable computer, not a personal computer. Examiner notes that Drainville teaches a portable computer (22) as claimed in the instant invention.

18. Appellant argues in Section D1 that neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer in a sleep mode. Examiner agrees. If Drainville disclosed this feature, an anticipatory rejection would have been made under 35 U.S.C. § 102. Similarly, if King disclosed this feature it would have been a rejection under 35 U.S.C. § 102. It is the combination of the teachings of Drainville and King that make a portable computer being awakened from a sleep mode by a wireless communication from a PDA obvious to one of ordinary skill in the art.

19. Appellant argues in Section D1 that Drainville does not disclose a portable computer. Examiner disagrees. The server 22 can be moved and is thus portable. In addition, numerous patents cite that servers can be both portable and battery operated; for instance, US Patent No 5699357 to Carvey teaches this verbatim. US Patent No 6470401 to Peterson teaches a server being a portable laptop computer. Evidence can also be found in the details of server operation. The server is not constructed at the place where it will be operated. Instead, it is built at a factory and then shipped to its destination, thus making it portable. Appellant further argues that since the server is wired to a phone line through a modem it is not portable. Expanding this logic, laptops, which are connected to the Internet by modems and phone lines, are not portable. This argument is erroneous since laptops are, by definition, portable.

20. Appellant states "King does not disclose or suggest communication between a personal digital assistant and a personal computer in a sleep mode". Examiner agrees. Appellant is making a contention that is not claimed. King does not disclose communication between a PDA and a personal computer because the claims require that the computer be portable. The distinction between the personal computer that the Appellant references, which is for use by one or a small group of individuals, and the portable

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computer that the instant invention claims, which is capable of being moved, would have been clear to one of ordinary skill in the art at the time of invention.

21. Appellant argues in Section D1 that King does not disclose or suggest communication between a PDA and a personal computer in a sleep mode and does not disclose any entity in sleep mode of being awakened from a sleep mode. Examiner agrees. Should King have disclosed these features an anticipation rejection would have been made, instead of obviousness rejection. The obviousness rejection combining Drainville and King makes a portable computer being awakened and communicating with a PDA obvious to one of ordinary skill in the art at the time of invention.

22. Appellant argues in Section D1 that Drainville does not disclose a portable computer, does not disclose a PDA, and does not disclose a portable computer being awakened from a sleep mode by a PDA. Examiner agrees. King is used to teach that a PDA can be used to wirelessly communicate with the portable computer disclosed in Drainville. The system taught by Drainville using the PDA taught by King to form rejection under 35 U.S.C. § 103, would make the instant invention obvious to one of ordinary skill in the art at the time of invention.

23. Appellant argues in Section D1 that the on demand server taught by Drainville is not a portable computer. Examiner disagrees. As discussed above with respect to paragraph 20, the server disclosed in Drainville is a portable computer.

24. Appellant argues in Section D1 that the tapping web server taught by Drainville is not a PDA. Examiner agrees. That is why the King reference was used to create an obviousness rejection under 35 U.S.C. § 103. King teaches a PDA communicating wirelessly with a computer and the combination of the Drainville and King references would have made the instant invention obvious to one of ordinary skill in the art at the time of invention. Further, Examiner notes that the rejection does not rely on the tapping web server. The client 10 of Drainville sends a communication that wakes up the portable computer. The means by which the computer is awakened are not claimed.

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25. Appellant states, "In Drainville, client 10 does not communicate with the on-demand server 22 until after web server 22 has been awakened by the tapping server. Therefore, no communications (wireless or otherwise) from client 10 is used to wake up the on-demand server." Examiner disagrees. These two assertions are independent of one another. Since the claims only require that a portable computer be awakened from a sleep mode in response to a wireless communication from a PDA, the fact that the client 10 does not directly wake the server 22 is not of interest. As long as the server 22 is awakened in response to a communication from the client 10, the claim limitations have been met. Drainville discloses a portable computer (22) that is awakened from a sleep mode in response to a wireless communication (column 1, lines 62-64) from a client (10). King teaches a PDA that communicates wirelessly with a computer (column 15, lines 52-54). The substitution of the PDA taught by King for the client taught by Drainville would have made the instant invention obvious to one of ordinary skill in the art at the time of invention.

26. Appellant states, "neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer". Examiner agrees. Appellant is arguing a point that is not claimed in the instant invention. The claims state that the computer receiving the communication is a portable computer, not a personal computer. A portable computer can be moved while a personal computer is for use by an individual. Examiner notes that Drainville teaches a portable computer (22) as claimed in the instant invention.

27. Appellant argues in Section E1 that neither Drainville nor King is concerned with communication between a portable digital assistant and a personal computer. Examiner agrees. The references used independently would not have been able to reject the claims of the instant invention. Nonetheless, the combination of Drainville and King in a rejection under 35 U.S.C. § 103 would have made a portable computer being awakened from a sleep mode by a PDA obvious to one of ordinary skill in the art.

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28. Appellant argues in Section E1 that Drainville does not disclose a portable computer. Examiner disagrees. The server 22 of Drainville can be interpreted as the portable computer of the instant invention. The fact that the computer has been moved from the factory where it was made to the point of operation evidences that the server is portable. In addition, it would have been obvious to one of ordinary skill in the art at the time of invention that a server could be portable, as evidenced by numerous patents. US Patent No 5699357 to Carvey teaches a server that is portable and battery powered, and US Patent No 6470401 to Peterson teaches a server being a portable laptop computer. Appellant further argues that since the server is wired to an idle phone line through a modem it is not capable of being moved and is not portable. However, the modem could be disconnected and the server moved, thus making the server portable.

29. Appellant states "King does not disclose or suggest communication between a personal digital assistant and a personal computer in a sleep mode". Examiner agrees and would like to note that Appellant is making an assertion that the PDA and a computer in a sleep mode communicate, which is based on unclaimed limitations. The claims state that the portable computer is in a sleep mode and is then awakened in response to a wireless request from the PDA to access information. The PDA and portable computer then communicate wirelessly and a response to the request is transmitted. Drainville teaches a client that sends a communication to a portable computer that is in a sleep mode (column 1, lines 62-64). In response to the communication, the portable computer is awakened and then responds to the communication (column 1, lines 62-64; column 2, lines 25-31). King teaches that a PDA can be used to wirelessly communicate with a computer (column 15, lines 52-54). Therefore, by modifying the system of Drainville with the PDA with wireless communication taught by King, it would be obvious to one of ordinary skill in the art at the time of invention that a PDA could wirelessly wake a portable computer with a communication and receive a response to the communication. Further, Appellant is stating that King does not disclose communication between a PDA and a personal computer; however, the computer,

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which Appellant asserts is a personal computer, is not claimed. The claims state that a portable computer receives a communication. There is a distinction between the personal computer that the Appellant references, which is for use by one or a small group of individuals, and the portable computer that the instant invention claims, which is capable of being moved. Examiner notes that Drainville discloses a portable computer (22).

30. Appellant argues in Section E1 that King does not disclose or suggest communication between a PDA and a personal computer in a sleep mode and does not disclose any entity in sleep mode of being awakened from a sleep mode. Examiner agrees. Again, if King disclosed these features the rejection would have been anticipatory under 35 U.S.C. § 102, instead obvious under 35 U.S.C. § 103. The combination of Drainville and King makes a portable computer being awakened and communicating with a PDA obvious to one of ordinary skill in the art at the time of invention.

31. Appellant argues in Section E1 that Drainville does not disclose a portable computer, does not disclose a PDA, and does not disclose a portable computer being awakened from a sleep mode by a PDA. Examiner agrees. King is used to teach that a PDA can be used to wirelessly communicate with the portable computer disclosed in Drainville. The system taught by Drainville, being modified to include the PDA taught by King, would make teach these features of the claimed invention.

32. Appellant argues in Section E1 that the on demand server of Drainville is not a portable computer. Examiner disagrees. As discussed above with respect to paragraph 31, the server disclosed in Drainville is a portable computer.

33. Appellant argues in Section E1 that the tapping web server, also of Drainville, is not a PDA. Examiner agrees. Should this feature have been disclosed in Drainville, an anticipation rejection would have been made. Instead, an obviousness rejection was made using Drainville and King, which teaches a PDA communicating wirelessly with a computer. It is the combination of the Drainville and King references that would have made the instant invention obvious to one of ordinary skill in the art at the

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time of invention. Further, Examiner notes that the tapping web server is not germane to the rejection issued since the client 10 of Drainville sends the communication that wakes the portable computer.

34. Appellant states, "In Drainville, client 10 does not communicate with the on-demand server 22 until after web server 22 has been awakened by the tapping server. Therefore, no communications (wireless or otherwise) from client 10 is used to wake up the on-demand server." Examiner disagrees. Appellant is stating that since the client does not directly wake the server it has no part in waking the server. This contention is incorrect and this limitation is not claimed. The claims state that a portable computer is awakened from a sleep mode in response to a wireless communication from a PDA. Drainville discloses a portable computer (22) that is awakened from a sleep mode in response to a wireless communication (column 1, lines 62-64) from a client (10). King teaches a PDA that communicates wirelessly with a computer (column 15, lines 52-54). The substitution of the PDA taught by King for the client taught by Drainville would therefore meet the limitations claimed in the instant invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Anand B. Patel

Conferees:

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